

EXAMINER'S AMENDMENT

An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with Jonathan Myers on 3/22/2010.

Claim 1, after replace:

"A process for the preparation of crystalline modification "G" of N-(trans--4-isopropylcyclohexyl carbonyl)-D-phenylalanine (nateglinide) of the formula (I)"

With

"A process for the preparation of crystalline modification "G" of N-(trans--4-isopropylcyclohexyl carbonyl)-D-phenylalanine (nateglinide) of the formula (I) and having the melting point, infra-red spectrum and Raman spectrum of claim 5" .

Cancel claims 3, 4 and 6-10.

The above amendments provide that the rejoined process claims depend upon all elements of the allowed product in claim 5.

The following is an examiner's statement of reasons for allowance:

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The prior art rejections under the Yahalomi references are withdrawn since applicants have shown by way of a Declaration under 37 CFR 1.132 that the physical characteristics of the g form crystals covered by the instant claims are physically different from the g form crystals of the references. see "Products of identical chemical composition can not have mutually exclusive properties." *In re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990). In this regard, other references such as US 7534913 also disclose g form crystals but are the same crystals prepared from isopropyl alcohol or isopropyl solvates described by Yahalomi, which have been distinguished by the Declaration.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karl J. Puttlitz whose telephone number is (571) 272-0645. The examiner can normally be reached on Monday to Friday from 9 a.m. to 5 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel Sullivan, can be reached at telephone number (571) 272-0779. The

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fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Karl J. Puttlitz/

Primary Examiner, Art Unit 1621